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PATENT AND TRADEMARK OFFICE

Attorney Docket No.: Google-41 (GP-099-00-US)

Appl. No.: 10/750,451

Confirmation No.: 4989

Appellant/Applicants: Ross KONINGSTEIN, et al.

Filed: December 31, 2003

Title: SUGGESTING AND/OR PROVIDING TARGETING CRITERIA FOR ADVERTISEMENTS

TC/A.U.: 3622

Examiner: Michael Bekerman

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R:

REPLY BRIEF

Further to the Examiner's Answer mailed on April 14, 2011 (referred to as "the Examiner's Answer" below), which defined a period for reply to expire on June 14, 2011, the appellant respectfully requests that the Board consider this Reply Brief.

Argument

This Reply Brief incorporates by reference, the Appeal Brief filed on January 10, 2011 ("the Appeal Brief"). Accordingly, the arguments presented in this Reply Brief are intended to supplement, not replace, arguments presented in the earlier-filed Appeal Brief. Further, since the arguments presented here are intended to supplement arguments in the Appeal Brief, the claims are to be grouped in accordance with the separate headings provided in the Appeal Brief and nothing in this Reply Brief shall constitute a waiver of any argument that the Board must consider the patentability of the separately grouped claims separately.

Although the arguments in the Examiner's Answer do not effectively rebut arguments in the Appeal Brief, the appellant would like to address some of the assertions with respect to certain claims set forth in the Examiner's Answer.

Response to Arguments in Examiner's Answer regarding the Claims of Group III and Group IV

The rejection of dependent claims 86 and 87 of Group III, and dependent claim 88 of Group IV, based on U.S. Patent Application Publication No. 2003/0055816 ("the Paine publication") should be reversed at least because the Paine publication does not teach that an accepted category is specifically associated with the keywords in

a data structure stored on a computer system, and that this specific and previously stored association is used to lookup the keywords.

In response to arguments presented in the Appeal Brief, the Examiner reiterates his position stating:

Appellant argues "the use of collaborative filtering in the Paine Publication to get terms (alleged to be keywords) used by other advertisers from existing terms (alleged to be categories) does not specifically associate the existing terms with the terms used by other advertisers". If a program is able to get one set of terms from another set of terms, those two sets of terms have to be inherently associated. If the terms were not associated whatsoever, then no terms would be returned. Once again, Examiner relies on the fact that "associated" is a very broad term. One term that is listed in a thesaurus as a synonym of another term is an example of an association. [Emphasis added.]

(Page 11 of the Examiner's Answer) As can be appreciated by the foregoing, the Examiner continues to argue that any association between terms inherently teaches an association of keywords and a category. However, in addition to improperly equating any term with a category, the Examiner's position ignores other recited features of the claims. Thus, this treatment of the claim language is improper because it ignores the context and meaning of the claim taken in its entirety. (See MPEP 2141.02(I).) Claim 86, for example, includes, by virtue of its dependency from claim 1:

looking up, with the computer system, one or more keywords using the accepted category and a previously stored association of a plurality of categories and keywords... [Emphasis added.]

(from element (b) of claim 1 from which claim 86 depends), and recites:

wherein the category is specifically associated with the keywords in a data structure stored on the computer system and this specific association is used to lookup the keywords. [Emphasis added.]

(claim 86). Example data structures that store this association consistent with claims 86-88 are depicted in Figure 3 of the specification.

Thus, the Examiner is apparently arguing that the Paine publication inherently teaches that an accepted term (alleged to teach the claimed category) is specifically associated with certain keywords in a data structure stored on a computer system, and that this specific and previously stored association is used to lookup those keywords. The appellant respectfully disagrees.

Inherency cannot be established by mere possibilities or even probabilities. The fact that a certain result or characteristic may occur or may be present in cited art is not sufficient to establish the inherency of that result or characteristic. (See MPEP

2112 (IV), citing In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).)

To support a finding of inherency, the Examiner must establish, through technical reasoning and/or evidence, not merely that terms have some loose association. Rather, the Examiner must establish that an accepted category is necessarily specifically associated with the keywords in a data structure stored on a computer system, and this specific and previously stored association is necessarily used to lookup the keywords.

In this instance, the Examiner offers no specific evidence to support his assertion and nothing in the Paine publication teaches these recited features. Such assertions of technical facts in the areas of esoteric technology or specific knowledge of an art must be supported by citation to some reference work recognized as a standard in the pertinent art.

Thus, the rejection of dependent claims 86-88 based on the Paine publication should be reversed for at least the reasons set forth above, as well as the reasons set forth in the Appeal Brief. The appellant respectfully requests that the Board reverse the Examiner's rejection of the claims of Group III and IV.

Response to Arguments in Examiner's Answer Regarding the Claims of Group V

The rejection of representative dependent claim 6 of Group V (which also includes claims 19, 32, 47, 60 and 73) based on the Paine publication should be reversed at least because the Paine publication does not teach performing qualification testing of the one or more keywords and determining if a keyword is qualified or unqualified for use as a targeting keyword of the advertisement, wherein each of the at least some of the keywords stored as one or more ad targeting keywords of the advertisement are qualified keywords.

In rejecting claim 6 of Group V (from which claim 7 depends), the Examiner contends that the Paine publication discloses a type of qualification testing in paragraph [0115]. Specifically, the cited portion of the Paine publication describes "filter[ing] out bad terms" produced by the Spidering technique. (Paragraph [0115] of the Paine publication) The filtering is based on the "frequency with which a term appears in documents on the World Wide Web, and the frequency with which users search for it." (Paragraph [0115] of the Paine publication) The Examiner's interpretation of "**qualification testing**" based on the "frequency with which a term appears in documents on the World Wide Web, and the frequency with which users search for it" is inconsistent with how one skilled in the art would interpret "qualification testing", in light of the specification. Specifically, the specification of the present application provides an example of such **qualification testing**, stating:

Figure 8 is a flow diagram of an exemplary method 800 that may be used to try keywords for qualification as targeting keywords in a manner consistent with the present invention. A keyword (or more than one keyword) is accepted. (Block 810). The trial operations may use one or more keywords as targeting keywords in the serving of an ad (or even a group of ads) (Block 820) and the performance of such ads may be tracked (Block 830). In one embodiment of the present invention, the serving of the ads using trial targeting keyword (s) may be limited to ad spots (inventory) that otherwise would be unused. After a certain amount of time and/or after a certain number of such ad serves, various branches of the method 800 may be performed responsive to various different performance levels. *If a keyword performs well (e.g., in general, or for a particular category), it may be marked as a keyword to be suggested, and/or as a qualified keyword (e.g., in general, or for the particular category) (Block 850) before the method 800 is left (Node 870).* In fact, generic creatives (for example, creative templates with certain advertiser information inserted) with qualified targeting keywords could be subject to expedited approvals. *If, on the other hand, a keyword does not perform well (e.g., in general, or for a particular category), it may be disqualified and marked as unusable (e.g., in general, or for the particular category) (Block 860) before the method 800 is left (Node 870).* In this way, advertisers can avoid the frustration of targeting their ads using poorly performing keywords. Although not shown, keywords can be assigned various different status

levels associated with various different levels of performance. In one embodiment, *performance for one or more keywords may be considered to be good if ads served pursuant to using the keyword(s) as targeting keywords perform (e.g., have a click-through rate) comparable to what salespeople and/or customers already think are the best keywords* (e.g., the keywords that they are already using). [Emphasis added.]

(Page 22, line 25 through page 23, line 20 of the present application) The proper interpretation of the claims must be consistent with the specification and thus with the interpretation that those skilled in the art would reach. (See MPEP 2111.)

Thus, the rejection of dependent claim 6 (as well as claims 19, 32, 47, 60 and 73) based on the Paine publication should be reversed for at least the reasons set forth above, as well as the reasons set forth in the Appeal Brief. The appellant respectfully requests that the Board reverse the Examiner's rejection of the claims of Group V.

Response to Arguments in Examiner's Answer Regarding the Claims of Group VI

The rejection of representative dependent claim 7 of Group VI (which also includes claims 8-10, 20-23, 33-36, 48-51, 61-64 and 74-77) based on the Paine publication should be reversed at least because the Paine publication

does not teach that the act of performing qualification testing of the keyword **tracks a performance of a set of one or more advertisements served using the keyword as an ad targeting keyword**, wherein the set of one or more advertisements includes the advertisement.

In response to arguments presented in the Appeal Brief, the Examiner states:

Appellant argues "merely tracking performance does not teach using such performance for purposes of performing qualification testing of keywords". Paine teaches tracking performance. **The reasons for the tracking (for purposes of performing qualification testing) are intended use and is given little patentable weight**. Paine still teaches both qualification testing and performance tracking. [Emphasis added.]

However, the appellant notes that claim 7 recites that "the act of performing qualification testing of the keyword **tracks a performance of a set of one or more advertisements served using the keyword as an ad targeting keyword**." Thus, the features of claim 7 cannot be considered merely "intended use" and further recites how qualification is performed.

Furthermore, the Examiner uses **parts of separate and distinct features** of the Paine publication in a way not disclosed by the reference. Specifically, the "filter[ing] out [of] bad terms" in the Spidering technique (which the Examiner alleges teaches qualification testing in claim 6) does not use (nor would

it need to use) tracked "clicks" of ads with respect to a certain search term to predict a "daily run rate" and "days remaining to expiration" (which the Examiner alleges teaches the qualification testing in claim 7). It is not clear that these different systems cited by the Examiner were intended to work together in the way the Examiner arranged.

Thus, dependent claim 7 (as well as claims 8-10, 20-23, 33-36, 48-51, 61-64 and 74-77) is not anticipated by the Paine publication for at least the reasons set forth above, as well as the reasons set forth in the Appeal Brief. The appellant respectfully requests that the Board reverse the Examiner's rejection of the claims of Group VI.

To reiterate, the foregoing is to supplement, not replace, arguments presented in the earlier filed Appeal Brief.

Conclusion

In view of the foregoing, as well as the arguments presented in the earlier filed Appeal Brief (incorporated herein by reference) the appellant respectfully submits that the pending claims are in condition for allowance. Accordingly, the appellant requests that the Board reverse each of the outstanding grounds of rejection.

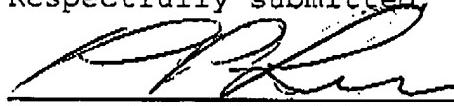
Any arguments made in this Appeal pertain only to the specific aspects of the subject matter claimed. Any

claim arguments, are made without prejudice to, or disclaimer of, the appellant's right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the appellant's remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the appellant's silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the appellant that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the appellant reserves the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

June 14, 2011


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